

REMARKS

Claims 1-23 are pending in the present application. Claims 1, 8 and 17 are independent claims.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 1-23 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Wang et al. (U.S. Pat. 6,603,761) (hereinafter “Wang”) in view of Chheda (U.S. Pat. 6,266,529) (hereinafter “Chheda”). The rejection is respectfully traversed in its entirety.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 1 and Wang each address different problems. Claim 1 addresses an inter-system (CDMA-GSM) handoff. In contrast, Wang discloses a method and system to provide GSM subscribers roaming into CDMA or TDMA networks, and CDMA or TDMA subscribers roaming into GSM networks, with basic call delivery wireless services as long as the roamers can pay the bill with their valid credit card (emphasis added) (Wang, Abstract). That is, Wang specifically deals with the payment issue when GSM subscribers roam into CDMA or TDMA networks, and CDMA or TDMA subscribers roam into GSM networks.

Claim 1 recites, among other things, elements “measuring at the mobile station a first parameter of a first signal transmitted by said first base station” and “measuring at the mobile station a second parameter of a second signal transmitted by said second base station” (emphasis added). In rejecting Claim 1, the Patent Office has alleged that Wang teaches such elements (Office Action, page 3, lines 8-12). Applicants respectfully disagree.

First, the Patent Office fails to pinpoint exactly where in Wang the element “measuring at the mobile station a first parameter of a first signal transmitted by said first base station” (emphasis added), as recited in Claim 1, is taught or suggested (see Office Action, page 3, lines 8-9). Indeed, after a diligent search, Applicants are unable to find the word “measure” or “measuring” in Wang.

Next, even though the Patent Office has alleged that col. 4, lines 1-31 and Fig. 1 of Wang teach the element “measuring at the mobile station a second parameter of a second signal transmitted by said second base station” (emphasis added), as recited in Claim 1, Wang fails to support the Patent Office’s own allegation. Col. 4, lines 1-31 and Fig. 1 of Wang teach a typical wireless infrastructure that provides cellular/PCS services like call origination and call delivery for a roaming mobile device. Nowhere in Wang is it taught the element “measuring at the mobile station a second parameter of a second signal transmitted by said second base station” (emphasis added), as recited in Claim 1.

Moreover, Wang enables a cellular subscriber to receive phone calls either in a home network (e.g., London) or while away from the home network (e.g., in Chicago) (Wang, col. 1, lines 17-20). If the Patent Office’s allegation that Wang taught the foregoing-described elements of Claim 1 were true, Applicants would respectfully ask the Patent Office to explain how a

mobile station in London measures “a first parameter of a first signal transmitted” by a first base station in London and measures “a second parameter of a second signal transmitted” by a second base station in Chicago.

Furthermore, Claim 1 recites, among other things, an element limitation “the ADDS message being a type of tunneling mechanism which transparently passes within the CDMA system GSM parameters” (emphasis added). In rejecting Claim 1, the Patent Office has alleged that Wang’s mobile IP tunnel teaches such element limitation (Office Action, page 3, lines 17-19). Applicants respectfully disagree.

Wang’s mobile IP tunnel 285 “allows Internet standard-based routers to route IP packets from one end of a tunnel to the other end of the tunnel, regardless of the topology of the underlying IP network” (emphasis added) (col. 8, lines 38-41). Thus, Wang’s mobile IP tunnel 285 deals with IP packets. This is further confirmed by Wang’s FIG. 4, where the home H.323 server 251 converts 283 the circuit call 257 to a packet call (i.e., voice-over-IP) and forwards the packets to the HA which forwards the packets over the Mobile IP tunnel 285 to the FA in the visited H.323 server 211 (see col. 8, lines 52-56), and where the FA in the visited H.323 server 211 converts 287 the packets received via the Mobile IP tunnel 285 to a circuit call 286 and relays the circuit call to the visited MSC 210 (see col. 8, lines 62-64).

Thus, since Wang’s mobile IP tunnel deals with IP packets, it cannot transparently pass “within the CDMA system GSM parameters,” as recited in Claim 1.

Moreover, Claim 1 and Chheda each address different problems. Claim 1 addresses an inter-system (CDMA-GSM) handoff. In contrast, Chheda addresses an inter-sector handoff within a single CDMA cell. Thus, Chheda relates to a non-analogous field of art.

Thus, Claim 1 is allowable over Wang in view of Chheda.

Independent Claims 8 and 17 were rejected based on the same rationale as applied to Claim 1, and are thus allowable.

As a result, all pending Claims 1-23 are allowable.

CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Applicants hereby request a one-month extension of time to respond to the Office Action dated January 17, 2007 and having a time for response up to and including May 17, 2007. Please charge the requisite fee for this Extension of Time to Deposit Account No. 17-0026.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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